

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Chen et al.** § Group Art Unit: **2626**
§
Serial No. **10/617,530** § Examiner: **Neway, Samuel G.**
§
Filed: **July 10, 2003** § Confirmation No.: **3554**
§
For: **Traditional Chinese / Simple Chinese Flip Flop** § Attorney Docket No.: **AUS920030522US1**

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PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
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REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on September 10, 2009.

No fees are believed to be required to file a Reply Brief. If any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0457.

RESPONSE TO EXAMINER'S ANSWER

I. Response to New Arguments in Section 10 of the Examiner's Answer

A. Double Patenting Rejections

The judicial doctrine of obviousness-type double patenting precludes an applicant from extending the term of protection for a patented invention by claiming an obvious variant of the patented invention in a subsequent patent application. *See In re Longi*, 759 F.2d 889, 892 (Fed. Cir. 1985). Generally, an obviousness-type double patenting analysis entails two steps. First, as a matter of law, a court construes the claim in the earlier patent and the claim in the later patent and determines the differences. Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious type double patenting. *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 968 (Fed. Cir. 2001) (internal citations and footnote omitted). If a claim in a patent application is generic to the subject matter of a claim in a co-owned issued patent, the claim in the patent application is subject to rejection for obviousness-type double patenting unless a terminal disclaimer is filed. *See In re Goodman*, 11 F.3d 1046, 1053 (Fed. Cir. 1993).

1. Rejections of claims 1-5, 9-12, 16-20, and 24-27 on the ground of nonstatutory obviousness-type double patenting

The Examiner rejected claims 1-5, 9-12, 16-20, and 24-27 on the ground of nonstatutory obviousness-type double patenting. as being unpatentable over claims 1-16, and 30-45 of copending Application No. 10/617,526 in view of Chinese-English Dictionary (<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html>) and in further view of Chinese-English Lookup (<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>).

Appellants submit that the Examiner erred by making an improper double patenting rejection involving references other than a related patent application. The Examiner states:

... Appellants argue that the limitation, in claims 1 and 16, "responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character" is not anticipated or rendered obvious by the claims of co-pending 10/617,526 (Appeal Brief, page 11). However, the rejection is not made simply over the claims of co-pending 10/617,526 but over the claims of 10/617,526 in view of Chinese-English Dictionary and Lookup. Appellants' arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the claims of 10/617,526 in view of the references. Further, Appellants note that section 0 of the Brief explains the non-obviousness of claims 1 and 16 (Appeal Brief, page 11). However, the arguments in section 0, as they relate to claims 1 and 16, are geared towards the alleged non-obviousness of the claims over Chinese-English Dictionary in view of Lookup. The arguments are completely silent regarding the recitations of the claims of 10/617,526 in view of the references.

Appellants submit that the Examiner erred in application of the judicial doctrine of double patenting. The Examiner erred because he has not made the rejection based on a subsequent patent application by the inventors, but has brought in two additional references created by others than the inventors of the appealed application. The Examiner states “[h]owever, the rejection is not made simply over the claims of co-pending 10/617,526 but over the claims of 10/617,526 in view of Chinese-English Dictionary and Lookup.” Therefore, the Examiner erred because the Examiner could not demonstrate that the claims of application 10/617,526 were patentably indistinct from the appealed application. Rather, the Examiner brought in Chinese-English Dictionary and Lookup, the references cited in the 103 rejections in an attempt to cover all claim limitations. The Examiner conflated the judicial doctrine of double patenting with obviousness under 35 USC 103 and in so doing made an improper rejection. For the foregoing reasons, the rejections of claims 1-5, 9-12, 16-20, and 24-27 on the ground of nonstatutory obviousness-type double patenting should be overruled.

2. The rejections of claims 1-3, 9, 10, 16-18, 24 and 25 on the ground of nonstatutory obviousness-type double patenting

The Examiner rejected claims 1-3, 9, 10, 16-18, 24 and 25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-6, 26, 30-31 of

copending Application No. 10/631,070 in view of Chinese-English Dictionary (<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html>) and in further view of Chinese-English lookup (http://web.archive.org/web/2001_03091_04519/http://home.iprimus.com.au/richwarm/cel/cel.htm). In his answer, the Examiner states that “the same arguments as the ones put forth above by the Examiner in the nonstatutory obviousness-type double patenting of co-pending application 10/617,526 apply.”

Appellants submit that the Examiner erred in application of the judicial doctrine of double patenting. The Examiner erred because he has not made the rejection based on a subsequent patent application by the inventors, but has brought in two additional references created by others than the inventors of the appealed application. The Examiner states “the same arguments as the ones put forth above by the Examiner in the nonstatutory obviousness-type double patenting of co-pending application 10/617,526 apply.” Therefore, as explained above, the Examiner erred because the Examiner could not demonstrate that the claims of application 10/631,070 were patentably indistinct from the appealed application. Rather, the Examiner brought in Chinese-English Dictionary and Lookup, the references cited in the 103 rejections in an attempt to cover all claim limitations. The Examiner conflated the judicial doctrine of double patenting with obviousness under 35 USC 103 and in so doing made an improper rejection. For the foregoing reasons, the rejections of claims 1-3, 9, 10, 16-18, 24 and 25 on the ground of nonstatutory obviousness-type double patenting should be overruled.

B. 35 USC 103(a) rejections

1. Claims 1-4, 9-11, 16-19, and 24-26

The Examiner rejected claims 1-4, 9-11, 16-19, and 24-26 under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary in view of Chinese-English lookup. In his Answer, the Examiner makes several responsive arguments to Appellant’s brief which will be discussed below as first through third responsive arguments.

a. First responsive argument

In his Answer, the Examiner made the following argument:

Appellants argue that the "as" field (what Appellants have named A1) in the Chinese-English Dictionary graphical user interface (GUI) cannot be eliminated from the GUI without changing the method of operation and that the elimination would not have been obvious to one with ordinary skill in the art (Appeal Brief, page 18). The Examiner respectfully disagrees. The "as" field is used to provide the encoding format of the Chinese character translated into a target language in Chinese-English Dictionary ("as" in Figure on page 1 and related text). On the other hand, lookup discloses a translation method where the encoding format of the Chinese character is automatically discerned without requiring input from a user as in Chinese-English Dictionary (see "Does CEL work with both Big5 and GB text?", page 2). It would have been obvious to one with ordinary skill in the art to have used lookup's automatic encoding detector in Chinese-English Dictionary keeping its method of operation, which is natural language translation. It would have also been obvious to one with ordinary skill in the art to remove the "as" field because Chinese-English Dictionary using Lookup's automatic encoding detector would not need a user to enter a character's encoding format. Again note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

Appellants submit that the Examiner errs because the Examiner ignores all words in the claim. As stated in Appellant's principal brief:

However, the traditional Chinese character is not available. Appellants' claimed invention is not about obtaining a pronunciation or a dictionary meaning. Appellants' claimed invention is about Simplified Chinese/Traditional Chinese equivalency. Chinese is a character language. Simplified Chinese characters are not the same as Traditional Chinese characters. Lookup wholly fails to address Simplified Chinese/Traditional Chinese equivalency, and therefore, even if it could be technically combined with the Chinese English Dictionary, it would not be able to function as claimed in claims 1 and 16.

The Examiner has not addressed the argument that the claim is not addressed to a pronunciation or a dictionary meaning but to a Chinese character equivalency. Thus, the combination lacks the necessary disclosure to provide all limitations of the claim. The cited art must be able to provide a traditional Chinese and a simplified Chinese character equivalency in response to only a cut and paste and an activation of a submit button. None of the cited art, individually or in combination, can do this. Furthermore, the necessary intermediate steps cannot

be eliminated because the cited art does not disclose a way to automatically generate an equivalent character.

Moreover, the combined cited art cannot work as claimed because the cited art cannot automatically provide equivalency between Traditional Chinese and Simplified Chinese characters. The Examiner errs in ignoring the difference between a translation from one type of Chinese character into English and the claim limitations of displaying equivalent Chinese characters. The combination does not have the capability to automatically display equivalent Chinese characters between Traditional and Simplified characters. Lookup discloses the following:

What is CEL?

CEL is a **Chinese-English dictionary search utility** that is designed to help Chinese language learners to read Chinese electronic texts in other applications such as Web browsers and word processors.

In the illustration, the user has selected and copied a word in Notepad. CEL, having detected the word on the Windows Clipboard, has popped up to display the corresponding dictionary entry.



Lookup, page 1.

Lookup discloses that the character is repeated, displayed in pin yin and an English definition is provided. It does not provide character equivalency. The Examiner argues that the equivalency comes from the Chinese English dictionary reference but there is no evidence to support that Chinese English dictionary is able to automatically provide the equivalent character responsive to only a single cut and paste and a submit button. The Examiner has assumed that the capability is in the reference, but obviousness cannot be maintained by possibilities.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior

art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

b. Second responsive argument

The Examiner further states that:

Further, Appellants argue that the Examiner has set forth no technical argument to show how Lookup and Chinese-English Dictionary can be modified to produce a GUI as claimed by Appellants (Appeal Brief, page 19). However, the Examiner has indeed done just that in the rejection of claim 1 under 35 U.S.C. 103(a) as follows: The "as" field in Chinese-English Dictionary where a user selects the encoding type of the entered Chinese character will be unnecessary in the combination of Chinese-English Dictionary with Lookup, because the combination, using Lookup's method, is able to automatically discern the entered Chinese character's encoding. The "Output as" field will also be unnecessary because the combination of Chinese-English Dictionary with Lookup is able to display the Chinese character and all its translations so the user is not required to select which particular translations should be displayed. The "Look for" field which is used to select the position of the entered Chinese character is not a mandatory field for translation in Chinese-English Dictionary, it is simply a way to limit searches. This field could be omitted without affecting Chinese-English Dictionary's basic translation capabilities. It is again noted that it is well settled that the omission of an element/step and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

As explained above, Appellants submit that the Examiner has ignored all words of the claim limitation. The Examiner's premise is that "[t]he "as" field in Chinese-English Dictionary where a user selects the encoding type of the entered Chinese character will be unnecessary in the combination of Chinese-English Dictionary with Lookup, because the combination, using Lookup's method, is able to automatically discern the entered Chinese character's encoding." The reference cited by the Examiner does not provide a disclosure that automatically provides a display of equivalent Chinese characters where the equivalency is between simplified and

traditional Chinese characters. The combination would still require a manual selection. Indeed, the Examiner states “the combination of Chinese-English Dictionary with Lookup is able to display the Chinese character and all its translations so the user is not required to select which particular translations should be displayed.” The user is not seeking “all its translations.” The user is seeking an automatic display of character equivalency, which is not expressly disclosed by the combined art.

c. Third responsive argument

The Examiner further stated that:

Appellants also argue that their invention is about Simplified Chinese/Traditional Chinese equivalency and that Lookup wholly fails to address this issue. However, it is Chinese-English Dictionary (not Lookup) which is relied upon to teach Simplified Chinese/Traditional Chinese equivalency ("Search" and "Look It Up" in Figure on page 1 and "Results will show ... ", page 1, lines 4-7).

The Examiner’s argument points to the fundamental flaw in his reasoning. The Chinese-English Dictionary cannot be relied upon to teach simplified Chinese/traditional Chinese equivalency. The portion of Chinese-English Dictionary cited by the Examiner states in full:

This Chinese-English dictionary provides a searchable interface for the CEDICT dictionary put together by Paul Denisowski. Searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), pinyin, or English. Results will show the Chinese word, the pinyin representation of the word and the English definition. You can also click on the pinyin to hear how it is pronounced.

However, Appellants’ claim is directed to simplified Chinese and traditional Chinese character equivalency. The Examiner errs by combining a tool that fails to provide character equivalency with the “character reader” of Lookup to get the claims limitations. In the claims, different Chinese characters are required to be automatically displayed as equivalents, responsive to only a cut and paste and a submit button activation. Thus, none of the art discloses the requirements of the claims and the individual art cannot be combined to provide the limitations of each entire claim.

2. Claims 5, 12, 20, and 27

The Examiner rejected claims 5, 12, 20, and 27 under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary in view of Chinese-English Lookup referred as Lookup hereinafter and in further view of Hughes ("11CT3 Computer Science Sample Paper I", 1998, University of Dublin). In regard to claims 5, 12, 20 and 27, the Examiner states that:

Appellants submit that Hughes is not in a related field and that it would not be obvious to look to Morse Code in designing a Chinese equivalency tool (Appeal Brief, page 21). However, Hughes is also concerned with natural language translation, namely translating words represented in Morse code into English words (page 4, question 6 (b)) and it would have therefore been obvious to one with ordinary skill in the natural language translation art to have considered Hughes.

Appellants submit that the Examiner erred at least because Morse Code is not a "natural language" and thus converting a code into an English word is not a "natural language translation."

II. CONCLUSION

In view of the above, the Examiner's rejection of all claims should be overruled.

Date: November 6, 2009

Respectfully submitted,

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